



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,029	07/26/2000	PETER HIMMELSBACH	BEIERSDORF-6	5165

7590

07/23/2002

NORRIS MCLAUGHLIN & MARCUS

220 East 42nd Street

30th Floor

New York, NY 10017

EXAMINER

PIERCE, JEREMY R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/23/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D

Office Action Summary

Application No.

09/601,029

Applicant(s)

HIMMELSBACH ET AL.

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendment B, filed on May 24, 2002 has been entered. Claims 1, 3, 5, 8, 10, 15, and 17-20 have been amended. New claims 21-28 have been added. The amendment is sufficient to overcome the Claim Objections set forth in section 2 of the last Office Action. The amendment is also sufficient to overcome the 35 U.S.C. 112 and 103 rejections as set forth in sections 4-9 and 13-15 in the last Office Action.

Claim Rejections - 35 USC § 102/103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 2, 4, 7, 9, 10, 16, 17, 25, and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Riedel (U.S. Patent No. 4,967,740).

Riedel discloses a moisture vapor permeable tape for use on mammalian skin (column 1, lines 8-12). The backing material can be nonwoven and particularly a stitch-bonded fabric (column 3, lines 40-59). Riedel discloses that the preferred backing exhibits a desired combination of inherent properties such as moisture vapor permeability, softness, yield modulus, and strength. Although Riedel does not explicitly teach the limitation of tensile strength in accordance with the N/cm measurement, it is reasonable to presume that said limitations are inherent to the invention. Support for

Art Unit: 1771

said presumption is found in the use of similar materials (i.e. polyester) and in the similar production steps (i.e. stitch-bonded nonwoven) used to produce the medical tape. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, it would have been obvious to a person having ordinary skill in the art to provide additional strength to the stitch-bonded nonwoven fabric in the scope of Applicant's claims, since varying such a property is common in the art and the motivation to provide a tape with the desired strength is not uncommon. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. As to the "doped" adhesive limitation, the pressure sensitive adhesive can be a variety of materials, which are further used with primers, tackifiers, and other additives (column 6, lines 13-25). Such additives would make the adhesive doped, since they no doubt comprise an active substance. With regard to claim 4, although Riedel does not explicitly teach the limitation of the compression force generated by the backing material at an elongation of 20 to 70%, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyester) and in the similar production steps (i.e. stitch-bonded nonwoven) used to produce the medical tape. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, it would have been obvious to one having ordinary skill in the art to provide a compression force of from 0.2 N/cm to 10 N/cm at an elongation of from 20 to 70% in order to create a medical tape with the desired strength, elongation, and break properties that are known in the art to

Art Unit: 1771

be adjustable. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With regard to claim 7, the fact that Riedel discloses a medical tape would mean that the material is capable of tearing. With regard to claims 10, 25, and 26, although Riedel does not explicitly teach the limitations of dynamic-complex glass transition temperatures, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. synthetic rubbers and polymers) and in the similar production steps (i.e. adhesive material used for skin) used to produce the medical tape. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, it would have been obvious to one having ordinary skill in the art to use adhesive with the claimed glass transition temperatures in order to provide the optimal amount of tackiness for use as a medical tape. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With regard to claim 16, although not specifically mentioned, the material disclosed by Riedel is capable of being sterilized by gamma radiation. With regard to claim 17, the material is treated with a release coating for low adhesion (column 4, lines 3-14).

Claim Rejections - 35 USC § 103

4. Claims 3, 5, 15, 21-23, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel.

With regard to claims 3, 21, and 22, Riedel does not disclose how many stitches are present on the web of a stitch-bonded fabric per centimeter. It would have been obvious to one having ordinary skill in the art to provide 5 to 50 longitudinal stitches per centimeter in order to create a stitch-bonded fabric with a desired strength and rigidity provided by the stitches. With regard to claims 5 and 23, Riedel do not disclose a basis weight for the backing material. If not already inherent due to the use of Riedel as a medical tape, it would have been obvious to a person having ordinary skill in the art to provide a stitch-bonded nonwoven with a basis weight of between 10 and 350 grams per square meter, since such a range would include many tapes already known in the medical art, and selection of basis weight is a matter of design choice for the intended use of the tape. With regard to claims 15, 27, and 28, Riedel does not disclose the weight per unit area of the adhesive. It would have been obvious to one having ordinary skill in the art to provide between 130 and 500 grams per square meter of adhesive in order to create a medical tape with the desired amount of adhesion property fit for its intended use.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodenschatz et al. (U.S. Patent No. 6,074,965).

Riedel does not teach reinforcing fibers in the nonwoven web. However, Bodenschatz et al. already teach a medical material that is supported with high-strength fibers with a maximum tensile strength over 60 cN/tex (Abstract). It would have been obvious to one having ordinary skill in the art to reinforce the stitch-bonded nonwoven

Art Unit: 1771

web of Riedel with high-strength fibers in order to create a tape with increased strength, as taught by Bodenschatz et al.

6. Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel in view of Merkle et al. (U.S. Patent No. 5,527,536).

Riedel does not disclose the use of a releasable active substance in the adhesive material. Merkle et al. teach that an active ingredient may be incorporated into the pressure-sensitive adhesive layer that contacts human skin (column 1, lines 10-28). It would have been obvious to one having ordinary skill in the art to provide the pressure sensitive adhesive of Riedel with a releasable active substance in order to create a medical tape that can slowly release medicine onto the skin site location of the tape, as taught by Merkle et al. With regard to the amount of releasable active substance, Merkle et al. disclose the active substance to be present in the adhesive in the amount of 2.5 to 25% by weight (Abstract).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel in view of Bredahl et al. (U.S. Patent No. 5,539,033).

Riedel fails to disclose foaming the adhesive layer prior to application to the backing layer. Bredahl et al. teach a process for making pressure sensitive adhesive tape, including medical tapes (column 9, lines 43-50). Bredahl et al. disclose the adhesive layer can be foamed (column 8, lines 58-65). It would have been obvious to one skilled in the art to foam the adhesive prior to applying to the backing layer in order to increase the air permeability of the adhesive.

8. Claims 12, 13, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel in view of Ganschow (U.S. Patent No. 5,629,078).

With regard to claims 12 and 13, Riedel does not disclose the manner in which the adhesive is applied to the backing material. Ganschow discloses a back-coated adhesive tape based on a stitch-bonded web (column 1, lines 1-8). Ganschow teaches the application of the adhesive by various processes, including screen printing and spraying (column 2, lines 4-11). It would have been obvious to one having ordinary skill in the art to apply the adhesive to the backing material of Riedel in a manner disclosed by Ganschow, as a matter of obvious design choice. With regard to claims 18 and 20, Riedel does not disclose the further providing of an additional layer to the medical tape. Ganschow teaches providing such layers in order to make the tape easily releasable when wound into a roll. Ganschow adds a water repellent foam layer (column 1, lines 35-45) and an acrylate lacquer on top of the foam (column 1, lines 61-65). It would have been obvious to one having ordinary skill in the art to provide the tape of Riedel with the foam and acrylate lacquer in order to make the tape waterproof and easily releasable, as taught by Ganschow.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel in view of Ganschow as applied to claim 12 above, and in further view of Crawley et al. (U.S. Patent No. 5,948,707).

Ganschow discloses applying the adhesive to the backing layer by means of screen-printing, but does not specifically state that the adhesive will be in the form of polygeometric domes. Crawley et al. disclose a non-slip waterproof fabric (Abstract).

Art Unit: 1771

Via screen-printing, Crawley adds a layer of elastomeric material in the forms of dome-like projections to the fabric that gives the fabric a gripping capability when contacted with skin (column 7, lines 5-45). It would have been obvious to one skilled in the art to put the adhesive layer in the form polygeometric domes in the tape taught by the combination of Riedel and Ganschow in order to make a tape that did not adhere too strongly to the human skin, and was easily peelable.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel in view of Seabold et al. (U.S. Patent No. 4,315,047).

Riedel do not teach coating the backside of the tape with metal vapor. Seabold et al. teach that adhesive tapes may be coated with metal vapor on the backside as a means of rendering the tape opaque (column 6, lines 65-68). It would have been obvious to one having ordinary skill in the art to add metal vapor to the tape of Riedel in order to make the tape non-transparent, as taught by Seabold et al.

Response to Arguments

10. Applicant's arguments filed May 24, 2002 have been fully considered but they are not persuasive.

11. Applicant argues that Riedel does not teach a nonwoven that is overstitched, i.e. stitch-bonded, or adhesive that is doped. However, the Examiner has pointed out in the rejection above where these items are clearly disclosed.

12. Applicant argues that the material of Riedel does not inherently possess the same tensile strength values as claimed by the Applicant. The rejection was based on

Art Unit: 1771

the fact that similar materials and processes disclosed by the Applicant to make the backing material are present in the backing material of Riedel. Even if not present, strength is a known desired feature in the art of medical tape, and any modification known to a person of ordinary skill in the art could be used to increase the strength as an obvious modification, such as supplying high-strength polyester instead of low-strength polyester. Applicant's comparison of strength values provided by Riedel to those of the present invention is moot, since the values are not in similar units, and cannot be converted into similar units. For instance, one Kg-force unit equals approximately 9.8 Newtons. However, Applicant cites his strength values in Newtons/cm, thus indicating a different standard used in testing the strength of the materials. Furthermore, Applicant states that Riedel does not disclose a tensile strength value above 5. However, Table 2 clearly shows three values above 5, and one that is above 10 for Example 5.

13. Applicant argues that other properties, such as stress elongation clearly differentiate the present invention from the material disclosed by Riedel, citing that Applicant's stress elongation of 28% is nowhere near Riedel's minimum value of 120%. However, Applicant again overlooked Example 5, where the increased strength provides for lower elongation values, including 28% for two specific examples.

14. Applicant argues a foam/release layer is required in Ganschow, but Applicant's disclosure has examples where no release layer is present. However, the Examiner is not basing the rejection on Applicant's disclosure, but rather on the present claims. The

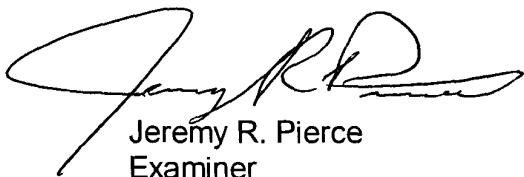
same reasoning applies for Applicant's arguments against the adhesive component taught by Merkle et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

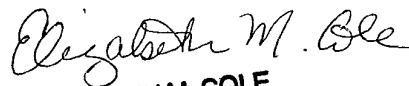
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeremy R. Pierce
Examiner
Art Unit 1771

July 17, 2002



ELIZABETH M. COLE
PRIMARY EXAMINER